Supreme Court, U.S.
FILED

01-35 JUL 03 2001

OFFICE OF THE CLERK

No.

IN THE

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ of Certiorari
To The U.S. Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

VINCENT L. CARNEY
Attorney for Petitioner
3041 NORTH 70TH STREET
LINCOLN, NEBRASKA 68507
(402) 465-8808

36 pp

QUESTIONS PRESENTED FOR REVIEW

1. Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?

2. Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999) ?

3. May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be expanded under the doctrine of equivalents?

PARTIES TO THE PROCEEDING

Petitioner: Senior Technologies, Inc.

Petitioner's Corporate Disclosure Statement:

> Senior Technologies, Inc. has no parent company and has issued no shares to the public.

Counsel for Petitioner:

Vincent L. Carney
3041 North 70th Street
Lincoln, Nebraska 68507
(402) 465-8808
(402) 465-8810 (FAX)

Respondent: R.F. Technologies, Inc.

Counsel for Respondent:

Jane C. Schlicht
Raymond D. Jamieson
Cook & Franke, S.C.
660 East Mason Street
Milwaukee, Wisconsin 53202
(414) 217-5900
(414) 271-2202 (FAX)

TABLE OF CONTENTS

QUESTIONS PRESENTED FOR REVIEW i

PARTIES TO PROCEEDING ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES v

OPINIONS BELOW 1

JURISDICTION 1

STATUTES INVOLVED 2

STATEMENT OF CASE 3

I. Summary 3

II. The Action and Jurisdiction 5

III. Trial, Judgment, Findings of Fact and Conclusions of Law 6

IV. Appeal to the U.S. Court of Appeals for the Federal Circuit 6

V. Holding of U.S. Court of Appeals for the Federal Circuit 7

VI. Claim Presented for Review 8

REASONS FOR ALLOWANCE OF WRIT 9

I. Summary 9

II. First Question Presented for Review 10
A. Federal Question 11
B. Conflict With Other Decisions 16

III. Second Question Presented for Review 17
A. Federal Question 17
B. Conflict With Other Decisions 21

IV. Third Question Presented for Review 22
A. Federal Question 22
B. Conflict With Other Decisions 28

V. Conclusion 28

TABLE OF AUTHORITIES

Cases

Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.,
73 F.3d 1573, 37 USPQ2d 1365
(Fed. Circ. 1996) 5, 7, 10, 23, 24, 28

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,
187 F.3d 1381,51 USPQ2d 1959
(Fed. Cir. 1999) 5, 7, 9, 10, 17, 18, 22, 28

McCarty v. Lehigh Valley R. Co.,
160 U.S. 110, 16 S.Ct. 240,
40 L.Ed. 358 (1895) 9, 11, 16, 17

North American Vaccine, Inc. v. American Cyanamid Co.,
7 F.3d 1571, 28 USPQ2d 1333
(Fed. Cir. 1993) 11

Renishaw PLC v. Marposs Societa' Per Azioni,
158 F. 3d 1243, 48 USPQ2d 1117,
(Fed. Cir. 1998) 9, 11, 16

Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.,
520 U.S. 17, 117 S. Ct. 1040,
137 L.Ed.2d 146 (1997) 10, 21, 22, 28

Statutes

28 U.S.C. 1254(1) 2

28 U.S.C. 1338(a), 1400(b), 2201 6

35 U.S.C. 102 ..... 3, 24

35 U.S.C. 112 ..... 2, 14, 15, 18

35 U.S.C. 271 ..... 3, 6

35 U.S.C. 281, 283, 284 and 285 6

The Petitioner, Senior Technologies, Inc., respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit, entered in this proceeding on March 12, 2001.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit for which review is sought, *Senior Technologies, Inc. v. R.F. Technologies, Inc.*, is an unpublished decision (decided March 12, 2001) and appears in Appendix A, pages 1-25. The judgment order of the Court of Appeals issued as a mandate on April 12, 2001, and appears in Appendix B, pages 26-27.

The published decision of the United States District Court for the District of Nebraska, *Senior Technologies, Inc. v. R.F. Technologies, Inc.*, is reported at 58 F.Supp.2d 1076 (D. Neb. 1999) and appears in Appendix C, pages 28-66.

The Denial of the Petition for Rehearing in *Senior Technologies, Inc. v. R.F. Technologies, Inc.* (not reported) entered April 5, 2001, appears in Appendix D, pages 67-68.

JURISDICTION

This case is a patent infringement case decided and entered by the United States Court of Appeals for the Federal Circuit on March 12, 2001, attached hereto in Appendix A. A timely filed petition for rehearing by the

appellant was denied April 5, 2001, which denial is attached hereto in Appendix D.

The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1) (1970). The pertinent portions of 28 U.S.C. 1254 are:

> "§1254. Courts of appeals; certiorari; certified questions
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;...."

STATUTES INVOLVED

Title 35 U.S.C. §112 (July 19, 1952, ch. 950, §1, 66 Stat. 798; July 24, 1965, Pub. L. 89-83, §9, 79 Stat. 261; Nov. 14, 1975, Pub. L. 94-131, §7, 89 Stat.691):

> "§112 Specification
>
> * * *
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Title 35 U.S.C. §271 (July 19, 1952, ch. 950, §1, 66 Stat. 811; Sept. 24, 1984, Pub. L. 98-417, §202, 98 Stat. 1603; Nov. 8, 1984, Pub. L. 98-622, §101, 98 Stat. 3383; Aug. 23, 1988, Pub. L. 100-418, §9003, 102 Stat. 1563-64; Nov. 16, 1988, Pub. L. 100-670, §201, 102 Stat. 3988-3989; Nov. 19, 1988, Pub. L. 100-703, §201, 102 Stat. 4676; Oct. 28, 1992, Pub. L. 102-560, §2, 106 Stat. 4230; Dec. 8, 1994, Pub. L. 103-465, §533, 108 Stat. 4988):

> "§ 271 Infringement of patent
>
> (a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent."

STATEMENT OF CASE

I. Summary

On July 26, 1999, The U.S. District Court of the District of Nebraska issued its findings of fact and conclusions of law and ordered that judgment be entered against the plaintiff, Senior Technologies, Inc., on plaintiff's infringement claims for the reason that the defendant, R.F. Technologies, Inc., has not infringed plaintiff's United States Patents 4,682,155 or 5,268,670 and that judgment be entered against the defendant and in favor of the plaintiff on defendant's counterclaims for the reasons that United States Patent 4,682,155 is not invalid under 35 U.S.C. § 102 and that the defendant

failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patent No. 4,682,155 and U.S. Patent 5,268,670 unenforceable. *Senior Tech., Inc. v. R.F. Tech.*, 58 F.Supp. 2d 1076 (D. Neb. 1999), see Appendix C.

The U.S. Court of Appeals for the Federal Circuit affirmed the District Court's judgment, but in doing so found clear error in its non-infringement holding, but then considered alternative grounds present in the record for affirming the District Court's conclusion of non-infringement, stating:

> "…. When the functions of the microprocessor are properly understood, and the claim is read on those functions, the presence of the microprocessor in the accused device provides no ground for noninfringement of the claims.
>
> We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us…."
>
> (Appendix A, page 10, beginning with line 2 of the first paragraph)

This petition is directed to the holdings by the U.S. Court of Appeals for the Federal Circuit: (1) that claim 1 should be construed to include a sensing-module housing, which is not literally recited in the claim (Appendix A, page 10, third and fourth paragraphs); (2) that the doctrine of equivalents cannot be applied under

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999), because claim 1 was amended to cure ambiguities (Appendix A, page 13, fourth paragraph); and (3) that any effort to expand claim 1 would eviscerate the construed limitation under *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Circ. 1996) (Appendix A, page 16, second paragraph).

II. The Action and Jurisdiction

This action was brought by the petitioner herein in the United States District Court for the District of Nebraska in July of 1997, for infringement of U.S. Patents 4,682,155 and 5,268,670. The defendant, R.F. Technologies, Inc., respondent herein, counterclaimed for a declaration of invalidity, noninfringement and unenforceability. The court entered judgment against the plaintiff and in favor of the defendant on plaintiff's infringement claim for the reason the defendant did not infringe plaintiff's United States Patent 4,682,155 or plaintiff's United States Patent 5,268,670. On defendant's counterclaims against the plaintiff, judgment was entered against the defendant and in favor of the plaintiff for the reasons that United States Patent 4,682,155 was not invalid under 35 U.S.C. 102 and R.F. Technologies failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patents 4,682,155 and 5,268,670 unenforceable. See *Senior Tech., Inc. v. R.F. Tech.*, 58 F.Supp. 2d 1076 (D. Neb. 1999) (Appendix C, pages 28-66).

Jurisdiction and venue of the Court of first instance was invoked under Sections 1338(a), 1400(b), and 2201 of Title 28 U.S.C. and Sections 271, 281, 283, 284 and 285 of Title 35 U.S.C.

The subjects in controversy were departure alert systems for providing an alarm when unauthorized persons, such as Alzheimer patients, passed through the doorway such as for example of a nursing home wearing a wrist transmitter.

III. Trial, Judgment, Findings of Fact and Conclusions of Law

On July 26, 1999, the District Court below entered its findings of fact and conclusions of law and a judgment order was entered on September 1, 1999, for the defendant, R.F. Technologies, Inc., on infringement, and for the plaintiff, Senior Technologies, Inc., on the counterclaim for invalidity. A copy of the reported case is in Appendix C, pages 28-66.

IV. Appeal to the U.S. Court of Appeals for the Federal Circuit

A Notice of Appeal was filed by Senior Technologies, Inc. on September 30, 1999, from the decision of noninfringement. A Notice of Cross-Appeal was filed by R.F. Technologies, Inc. on October 12, 1999, from the rulings on claim definiteness, invalidity, inequitable conduct, and attorney's fees. The case on appeal was argued on October 6, 2000, before the United States Court of Appeals for the Federal Circuit. It was decided on March 12, 2001. A petition for rehearing was sent to

the Court for filing on March 23, 2001. The petition for rehearing was denied on April 5, 2001.

V. Holding of U.S. Court of Appeals for the Federal Circuit

The Court of Appeals found clear error in the District Court's decision of noninfringement (Appendix A, page 9, lines 11-16), but applied alternative grounds supported by the record (Appendix A, page 10, second paragraph) for affirming the U.S. District Court for the District of Nebraska. In considering the alternative grounds for noninfringement of claim 1, the Court of Appeals construed: (1) claim 1 as being limited by a single sensing-module housing (a housing for the transmitter is recited in claim 1, but not a housing for the receiver or sensing module) having a receiving circuit in it (Appendix A, page 10, third paragraph, through page 13); (2) the sensing module as including the receiving circuit (Appendix A, page 10, third paragraph, through page 13); (3) that the sensing means must be in the single construed sensing-module housing (Appendix A, page 14); and (4) the doctrine of equivalents cannot be used to expand the claim under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Circ. 1999) and *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996). *Festo, supra* was applied on the ground that claim 1 was amended "such that the 'receiving circuit' would be specifically located 'in the sensing module'" (Appendix A, page 14), and *Athletic, supra* on the ground it would "eviscerate the construed limitation" (Appendix A, page 16).

VI. Claims Presented for Review

Claim 1 of U.S. Patent 4,682,155 (pages A000077-A000085 of the Joint Appendix before the Court of Appeals) is the only claim presented for review. Claim 1 is:

> "1. A security sensing system for monitoring the passage of persons through a door or like opening comprising:
>
> a transmitter module for installing on persons to be monitored, a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response, and alarm means energizable in response to the production of the output response to produce an alarm condition,
>
> the transmitter module including a housing having a transmitter circuit, a source of power for the transmitter circuit and transmitter antenna means installed therein,
>
> the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and
>
> said means responsive to the opening of the door including means to enable the receiving circuit in the sensing module whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means."

REASONS FOR ALLOWANCE OF WRIT

I. Summary

Each of the three questions presented for review relate to an aspect of the decision in this case that will make it difficult to know with certainty the scope of claims and thus more difficult to know with certainty what the public is free to do and what will infringe upon the patent rights of another.

Initially, the second question presented for review relates to the same point of law as another case for which this Court has recently granted a petition for a writ of certiorari, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 00-1543 (case before the U.S. Court of Appeals for the Federal Circuit reported in 187 F.3d 1381, 51 U.S.P.Q. 1959 (Fed. Cir. 1999)). This case provides an example of how the decision in *Festo, supra* is being applied. The Petitioner suggests that this petition be granted and either be heard with the *Festo* case which is now before this Court, or be delayed until this Court has decided the *Festo* case, so that this case can be remanded for interpretation in the light of the decision of this Court in *Festo, supra,* if this Court should overrule or modify the lower Court's decision in *Festo, supra.*

The first question presented for review relates to a conflict between the decision in this case between Senior Technologies, Inc. and R.F. Technologies, Inc. and in the previous cases of *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895) and *Renishaw PLC v. Marposs Societa' Per Azioni,* 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), as to when a

limitation can be construed to be in a claim if it is not already recited in the claim.

The second question presented for review relates to whether the amendment of a claim to refer back to a limitation recited in the original claim by repeating the limitation creates file wrapper estoppel. This question may involve the interpretation of the holding in *Festo, supra* that applies file wrapper estoppel to prevent the application of the doctrine of equivalents for any amendment related to patentability. This interpretation of *Festo, supra* conflicts with the decision in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040, 137 L.Ed. 2d 146 (1997).

The third question presented for review, while involving the scope of application of the doctrine of equivalents, relates most directly to the applicability of the doctrine of equivalents to expand the scope of a limitation construed to be in a claim. It thus involves both the *Festo* decision and another decision, *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996). *Athletic, supra* construed a claim to contain a limitation and refused to apply the doctrine of equivalents because expanding the construed limitation would eviscerate the construed limitation.

II. First question presented for review - Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?

A. Federal Question–Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

This case provides a new criteria for construing a claim to include a limitation not recited in the claim. This criteria appears to conflict with the long established law in which a limitation should not be imported into a claim unless it is necessary to rely on the limitation to determine what is meant by a limitation already in the claim, *Renishaw PLC v. Marposs Societa' Per Azioni,* 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), *McCarty v. Lehigh Valley R. Co.,* 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). Because literal infringement occurs only if the accused device contains every limitation in the claim, *North American Vaccine, Inc. v. American Cyanamid Co.,* 7 F.3d 1571; 28 USPQ2d 1333 (Fed. Cir. 1993), *cert. denied,* uncertainty as to the circumstances under which a limitation can be construed to be in a claim creates a corresponding uncertainty as to what the public can do and what would infringe on a patentee's rights. It is not clear how this new criteria applied by the Court of Appeals differs from reading a limitation into the claim from the specification, which is improper, *Renishaw, supra,* nor is it clear which limitations in the specification can be construed to be in the claim to limit its scope.

The new criteria construes a limitation to be in a claim when that limitation is associated in the description of the preferred embodiment with other limitations in the claim. In this case, the new criteria construes claim 1 to include the recitation of a sensing-module housing which is not literally recited in the claim, by referring to the specification and to another independent claim, claim 6, to determine that a sensing

means and a receiving circuit are in the same sensing-module housing and therefore, there must be a sensing-module housing.

More specifically, the Court of Appeals finds that the receiving circuit 14 is within the sensing module 14 and the sensing means is also part of the sensing module, and from that concludes the claim must be limited to a sensing-module housing 174. Although it does not appear to be significant, the Court of Appeals also states that the specification refers to the physical sensing module as being a sensing-module housing, but the specification does not refer to the physical sensing module as a sensing-module housing and clearly distinguishes the two. That statement may have been triggered by Figure 5 in which the sensing-module housing is indicated by the numeral 174 with a lead line entering the sensing-module housing and the sensing receiver or sensing module 14 is indicated by the lead line and arrow head spaced from the total unit including the sensing-module housing 174. The specific language used in this construction is:

> "Claim 1 describes a monitoring system that includes a 'sensing module for installing adjacent to a door opening to be monitored.' This sensing module, according to the claim, 'includ[es] a receiving circuit and associated sensing means.' Furthermore, claim 1 mentions a 'means to enable the receiving circuit <u>in the sensing module</u> . . . .' (emphasis added). Based on the language of the claim, one must conclude that the receiving circuit must be contained within the sensing module. This position is

consistent with the text and figures in the written description. Although the specification refers to the physical sensing module as a 'housing,' it is clear that the receiving circuit is located within it:

> The switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station. . . .

'155 patent, col. 8, lines 8-11. Furthermore, the prosecution history reveals that, in order 'to clarify ambiguities,' claim 1 was amended such that 'the receiving circuit' would be specifically located 'in the sensing module.' Hence, the claim language, specification, and prosecution history all indicate that the receiving circuit must be contained within the housing of the sensing module."

(Appendix A, page 10, beginning with the last paragraph)

and:

"A limitation not clearly addressed by the district court was the location of the "associated sensing means" in claim 1. As a matter of law, we conclude that the

> "associated sensing means" in claim 1 must be located within the same housing as the receiving circuit."
>
> (Appendix A, page 14, third paragraph)

The sensing-module housing for the receiver is referred to only in column 8 of the specification, lines 9 and 10, which describe the mechanical connection of the cables as quoted above. It is shown in Figures 6, 7, and 8, but is only indicated by its reference numeral 174 in Figure 5.

The sensing module or receiver circuit 14 is referred to throughout the specification most notably in: column 1, lines 15, and 55; column 2, lines 6, 8, 58 and 59; column 3, lines 7, 8, and 54; column 4, lines 27, and 36; column 5, lines 61 and 62; column 6, lines 44, 49, 54 and 59; column 7, line 50 and column 8, lines 16 (part of receiver or sensing module), 18, 24 and 36. The receiver is described as being in the sensing-module housing in the specification and is shown in two of the drawings as being in the sensing-module housing. The sensing means (antenna) is described in one embodiment as being in the sensing-module housing and in another as being on the door (Appendix A, pages 14-16).

The sensing module is not recited as a means plus function clause in claim 1 and there appears to be no other reason for construing this claim to include a sensing-module housing for the receiver other than the description in the specification which must describe the best mode of protecting the invention under 35 U.S.C. 112. The statute does not forbid a description of more

than one mode but only requires the description of the best mode. The Court of Appeals does not hold that it is essential to interpret the sensing module as being the sensing-module housing, and it is not necessary since the entire sensing module is shown and indicated by reference numeral 14 in Figure 4 of U.S. Patent 4,682,155 (see Appendix C, page 66).

Moreover, as stated by the Court of Appeals (Appendix A, page 15), the dependent claim 4 has language further limiting claim 1, although the Court of Appeals states it describes a different embodiment than claim 1. I cannot be directed to a different embodiment and still incorporate claim 1 by reference. Instead it is following 35 U.S.C. 112, which states in paragraphs 3 and 4:

> "A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.
>
> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers."

Claim 4 supports a construction that the sensing means may be outside of any sensing-module housing rather than supporting the construction that the sensing means and receiving circuit must be within the unrecited sensing-module housing. Moreover, the ordinary and usual meaning of the words, "associated with" is not "part of" but is "connected with" as an

outside television antenna can be connected by a long wire to an inside television set.

This manner of construing claims will create uncertainty in deciding when a claim is infringed and when a claim is valid since it appears to enable claims to be construed as including many limitations referring to an element in the claims that is described in the specification as being associated with a claimed element. There is no guidance concerning what details of the preferred embodiment can be construed into the claim and which cannot.

B. Conflict With Other Decisions

This case appears to be in direct conflict with *Renishaw PLC v. Marposs Societa' Per Azioni,* 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), cited by the U.S. Court of Appeals for the Federal Circuit, as well as with *McCarty v. Lehigh Valley R. Co.,* 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). These cases indicate that a limitation should not be imported into a claim unless it is necessary to rely on the limitation to determine what is meant by the limitation expressed in the claim. The rational for this holding was provided in *McCarty, supra* as follows:

> "[W]e know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim . . ., we should never know

where to stop."

McCarty v. Lehigh Valley R. Co., 160 U.S. 110, 116.

There is no need to further define the term "sensing module" by adding a new limitation in the claim nor does the Court of Appeals base its opinion on such a need. There is no issue relating to validity that involves a sensing-module housing in the lower Court's findings of fact and conclusions of law (see conclusions of law 32-41 in Appendix C, pages 58-61) and the sensing-module housing does not play a role in the reception of the radio signal nor its application. There is no indication in this record that either the applicant or the examiner thought claim 1 to be limited by the recitation of a sensing-module housing when claim 1 was allowed.

III. Second question presented for review -- Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999)?

A. Federal Question–Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

In its decision on alternative grounds, this Court of Appeals held the doctrine of equivalents could not expand the scope of claim 1 because of file wrapper estoppel. It held there was file wrapper estoppel on the

ground that claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." The record, on the other hand, shows that this limitation was in the original claim 1 and the amendment that is being discussed was not to cure an ambiguity as to the scope of the claim, but to conform a second recitation of a limitation to the first recitation of the limitation. The Court of Appeals relies on *Festo, supra* in its opinion. Thus *Festo, supra* is extended to cause editorial changes made to a claim that do not expressly limit the scope of the claim in themselves to create file wrapper estoppel. This extension will limit the ability of applicants and examiners in the United States Patent and Trademark Office to agree on editorial changes. It also raises issues that will cause doubt as to the scope of claims, such as how trivial must an editorial change be before it will not create file wrapper estoppel.

Claim 1 was amended after being rejected under 35 U.S.C. 112, second paragraph, as being indefinite in an Office action dated October 31, 1986 (page A001378 of the Joint Appendix before the Court of Appeals). That paragraph recited a number of other rejections under 35 U.S.C. 112, second paragraph, of a generally editorial nature, such as being unclear or containing typographical errors, such as "in" should be "is", or "transmitter" should read "transmitting". The applicant responded by making several changes to claim 1 (page A001382 of the Joint Appendix before the Court of Appeals) the relevant changes being to amend claim 1 from reading:

> "Claim 1.
>
> * * *
>
> ...a sensing module for installing adjacent

to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the trigger module to produce an output response...

* * *

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and,

means to enable the receiving circuit in response to the opening of the door whereby..."

to:

"Claim 1.

* * *

...a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response...

* * *

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and

said means responsive to the opening of the door including means to

> enable the receiving circuit in the sensing module whereby..."

The amended claim includes the same limitations as the claim before being amended except stated differently in two respects, namely: (1) both versions of claim 1 recite "...means responsive to the opening of the door to enable the sensing module to respond..." (starting on line 3 of each version of claim 1 quoted above), but later the second version recites:

> "said means responsive to the opening of the door including means to enable the receiving circuit..."

whereas the unamended version only again recites:

> "means to enable the receiving circuit in response to the opening of the door..."

and (2) both versions of claim 1 recite "the sensing module including a receiving circuit and associated sensing means..." but while the unamended version never repeats that the receiving circuit is in the sensing module, the amended version does repeat this statement at the end of the clause quoted above as follows:

> "...means to enable the receiving circuit in the sensing module..."

The differences between the amended and unamended versions do not relate to any new limitation but only to the manner in which the limitations are

expressed. Moreover, the amendments do not implicate prior art or validity over prior art.

Thus the original claim contained the limitation in issue in the fourth paragraph and the amendment to the fifth paragraph was made to change "response to the opening of the door" to correspond to language in the earlier phrase "means responsive to the opening of the door" in the second paragraph. For consistency, with the limitation of the "sensing module including a receiving circuit" in paragraph 4, the limitation was restated in paragraph 5 as "receiving circuit in the sensing module" for clarity. More importantly, the same limitation was already in the claim because the language "sensing module including a receiving circuit" is the same as "receiving circuit in the sensing module".

This interpretation of "sensing module" is consistent with the ordinary meaning of the word "module" as being a group of components and with the use of "module" in the specification. When referring to a group of components (i.e. sensing module), to say that a component (i.e. receiving circuit) is in the group of components (i.e. sensing module) or within that group of components is the same as saying that the group of components (i.e. sensing module) includes the component (i.e. receiving circuit).

B. Conflict With Other Decisions

This case appears to conflict with *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040; 137 L.Ed. 2d 146 (1997) in which this Court endorsed a compromise between the notice function of claims and fair protection objectives of

claims. That compromise was to limit the application of the doctrine of equivalents to the substitution of an element recited in a claim with an equivalent element but not to apply the doctrine of equivalents to the invention as a whole. 520 U.S. 17 at 29. The Court expressly rejected the position that the reason for an amendment is irrelevant to file wrapper estoppel limiting the doctrine of equivalents. 520 U.S. 17 at 30 and 31.

In this case, file wrapper estoppel is applied to prevent the doctrine of equivalents related to an amendment that conformed language in a later portion of a claim to language already in the originally filed claim at an earlier location. There is no explanation given for refusing to apply the doctrine of equivalents to this single element except to cite *Festo, supra*, although the construed limitation could have nothing to do with prior art.

IV. Third question presented for review -- May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be expanded under the doctrine of equivalents?

A. Federal Question–Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

The Court of Appeals denied the application of the doctrine of equivalents on another ground in addition to *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Circ. 1999) but one which raises the same questions about limitations on the doctrine of equivalents as raised by *Festo, supra*.

In this ground, the Court of Appeals cites *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581, 1582-83, 37 USPQ2d 1365, 1372, 1373-74 (Fed. Circ. 1996), as indicating that once the "receiver circuit and associated sensing means" are construed as being in the unrecited "housing", the doctrine of equivalents cannot expand the claim to include the associated sensing means as being outside of the unrecited sensing-module housing. In this case, the construed limitation "housing" was not put in the claim because of prior art but appears to be in the claim because the specification mentions it and the drawings show it, presumably as part of the description of the preferred embodiment.

However, this appears to be the product of a mistake in the role or lack of role played by the sensing-module housing in this invention. In *Athletic, supra,* the dispute was over the interpretation of a vital part of the invention recited in the claims, namely (strings of a tennis racket) "vary continuously between a maximum of d1=1/2 inch in the center, to zero for the last lateral strings near the tip and the heel of the frame". This recitation was inserted to distinguish over a reference to Lewis in which the splay did not vary. 73 F.3d 1573 at 1575. The Court of Appeals found the language susceptible of two meanings, one in which only two strings were necessary, resulting in infringement and one in which at least three strings were necessary resulting in no infringement, depending on which of two possible meanings of the word, "between" was accepted. 73 F.3d 1573 at 1579.

The Court of Appeals in *Athletic, supra* referred to documents and file wrapper comments indicating that three strings were required and referred to logic

explaining that in order to vary between one string and another requires a string between the two extremes. The opponent argued that there only had to be two strings. The Court of Appeals construed this clause, not to add elements because the strings were already recited, but to resolve the logical dispute over the scope of invention by interpreting language at the heart of the invention in a manner to distinguish over prior art.

Unlike *Athletic, supra*, in this case, the dispute resolves around what must be in a sensing-module housing and the only prior art question before the Court of Appeals relates to the existence of an "on sale" or "public use bar" under 35 U.S.C. 102. Section 102 of 35 U.S.C. bars protection if the invention was on sale or in public use more than one year before filing its application. This prior art did not hinge on the sensing-module housing at all. The problem centers on the failure of the decision to say why the sensing-module housing may be construed as being in claim 1, before showing that, if the sensing-module housing is construed to be in claim 1, then the receiver and sensing means must be in the sensing-module housing if only the sensing-module housing were in claim 1. There is a missing step about an insignificant part of a radio receiver, the sensing-module housing.

There is a good reason why the sensing-module housing was not recited in claim 1. The sensing-module housing does not play a role in detecting wanderers nor in performing any of the functions of the recited components such as transmitting, sensing or receiving. Unlike *Athletic, supra* (see 73 F.3d 1573 at 1581), this record does not contain any evidence that the examiner thought claim 1 was limited by a sensing-module housing or any evidence the examiner allowed claim 1

because of such a limitation or that the applicant intended such a limitation in claim 1. The word "housing" has no more connection to claim 1 than any other piece of hardware that is mentioned in the specification but not recited in claim 1, nor is there any confusion about the meaning of terms.

There is no mention of a sensing-module housing at all in this claim but only the functional language referring to the active electrical components such as "sensing module". There is no file wrapper estoppel relating to prior art and a full range of equivalents should be permitted. Clearly the sensing module can perform its function of sensing independently of an inanimate sensing-module housing which, according to its usual and common meaning, is nothing more than a cabinet used to carry the functional elements from place to place and to protect them from the elements. It does not perform and can not perform a function of sensing.

The word "module" also has a common and ordinary meaning. It means a group of functional units. This meaning is supported by the specification and record. For example, in the specification of the patent-in-suit, U.S. Patent 4,682,155, reference is made to "trigger modules" in column 1, lines 11-12 and 17-18 (page A000081 of the Joint Appendix before the Court of Appeals), and in other places. Reference is made to "transmitter modules" in column 1, lines 53-54 (page A000081 of the Joint Appendix before the Court of Appeals), and in column 6, line 40 (page A000083 of the Joint Appendix before the Court of Appeals), and in other places. Reference is made to "transmitter and receiver modules" in column 2, lines 7-8 (page A000081 of the Joint Appendix before the Court of Appeals), and in column 4, line 27 (page A000082 of the Joint

Appendix before the Court of Appeals); and to "transmitter module or unit" in column 3, lines 24-25 (page A000082 of the Joint Appendix before the Court of Appeals). Reference is made to "receiver unit or module" in column 1, line 15 (page A000081 of the Joint Appendix before the Court of Appeals), and so on. The specification is full of uses of the word "module" indicating a functional group and not suggesting that modules need a housing or have a housing or don't need a housing or don't have a housing.

For example, it can be noted that in column 3 (page A000082 of the Joint Appendix before the Court of Appeals), the actual words "sensing module" used in line 54 are indicated by the numeral 14 which is shown in Figure 3 as indicating a block diagram of the functional units and in Figure 4 indicating the circuitry. In Figure 4, there is no indication at all of a sensing-module housing and it is a schematic circuit diagram showing only components. Clearly the specification does not support the reading of the sensing module in the alternative ground for noninfringement as being or including a sensing-module housing. Its meaning is much broader in terms of the ordinary and common use of the word "module", and the manner in which the word "module" is utilized as a word in the specification of the patent. While modules of any kind can be inside of and include housings, there is nothing in this record to indicate they must include or be in a housing by their nature. They are nothing more than components gathered together to perform a function as shown consistently by the language and as indicated by the common and ordinary usage.

This reasoning seems to apply even more strongly to the CA9000 model since the Court of Appeals held

(Appendix A, page 13, third paragraph, through page 14, first paragraph):

> "Contrary to the district court's determination, the CA9000 model could arguably meet the single housing requirement since the microprocessor and the preceding circuitry can be found in the same housing (i.e., the control unit). However, in the CA9100, CA9120, and CA600, the circuitry preceding the microprocessor was removed and placed in the antenna unit mounted near the door, while the microprocessor remained in the control unit. As discussed above, both the microprocessor and the preceding circuitry corresponds to the limitation of "receiving circuit" in the '155 patent. By splitting the microprocessor and the preceding circuitry between two housings (i.e., the control unit and the antenna unit), these Code Alert products ceased to literally embody the single housing limitation of claims 1 and 6.
>
> As far as infringement under the doctrine of equivalents is concerned, both claims 1 and 6 were amended to overcome a rejection under 35 U.S.C. § 112, ¶ 2 (1994). Claim 1 was amended such that the receiving circuit is "in the sensing module," whereas claim 6 was amended to involve "a housing and a receiving circuit therein." Therefore, infringement under the doctrine of equivalents with regard to the CA9100, CA9120, and CA600 models is precluded. See Festo Corp., 2000 U.S. App. LEXIS 29979, at *25."

B. Conflict With Other Decisions

This case also appears to conflict with *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040; 137 L.Ed. 2d 146 (1997) in its reliance on *Athletic, supra* in a manner similar to the conflict when the Court of Appeals relied on the *Festo, supra* case. In *Warner-Jenkinson, supra*, this Court provided a compromise between the notice function of claims and the fair protection objective of claims. That compromise was to limit the application of the doctrine of equivalents to the substitution of an element recited in a claim with an equivalent element but not to apply the doctrine to the invention as a whole. 520 U.S. 17 at 29. The Court expressly rejected the position that the reason for an amendment is irrelevant to file wrapper estoppel limiting the doctrine of equivalents. 520 U.S. 17 at 30 and 31.

In this case, the fact that an element was construed as being in the claim is applied to prevent the doctrine of equivalents related to that limitation construed to be in the claim. The construction of the claim to include an element for reasons not related to prior art or any other substantial reason related to patentablity creates the same conflict between fair interpretation of the claim and predictability that was resolved by this Court in *Warner-Jenkinson, supra*. It should be resolved in the same manner.

V. CONCLUSION

The first question presented for review is to resolve confusion under the decision of the Court of Appeals about when a limitation can be construed to be in a

claim and the second and third questions presented for review are to resolve confusion under the decision of the Court of Appeals over when file wrapper estoppel will bar the application of the doctrine of equivalents from broadening the scope of a claim.

Under the second and third questions, the decision before this Court creates uncertainty as to what amendments can be safely made during examination of a patent application. Can the applicant correct spelling mistakes or grammatical mistakes, or as specifically involved here, can the applicant conform the language in one part of a claim to another part of the claim without waiving the doctrine of equivalents? Each of the questions relates to a conflict with existing case law. The questions are significant because this case leaves doubt as to what limitations can be added to claims from the specification and thus what the public may or may not do without infringing upon a patentee's rights.

Respectfully submitted,

VINCENT L. CARNEY
Attorney for Petitioner
3041 NORTH 70TH STREET
P.O. BOX 80836
LINCOLN, NE 68501-0836

Telephone: (402) 465-8808
Facsimile: (402) 465-8810